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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROYAN HERBERT BARTLEY, MICHAEL JOHN BRANSON,
STEVEN GENE HALVERSON, DAVID ALAN JAEGER, TODD MARK
KELSEY, and PAUL WILLIAM WERTZLER

Appeal 2007-2583
Application 09/892,435¹
Technology Center 2100

Decided: January 31, 2008

Before JOSEPH L. DIXON, JEAN R. HOMERE, and
ST. JOHN COURTENAY, III, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Filed June 27, 2001. The real party in interest in this appeal is International Business Machines, Corp.

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1 through 29. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

Appellants' Invention

Appellants invented a method and system for allowing a customer to access on his/her computer execution data previously downloaded from a vendor computer in exchange for enabling the transmission of the downloaded execution data to the vendor. (Spec. 4-5.) As depicted in Figure 1, the vendor computer (110) includes an execution data collection mechanism (130) for remotely collecting execution data from a customer computer (120). The vendor computer (110) further includes an execution analysis mechanism (140) that analyzes the collected execution data to determine if the customer needs additional product from the vendor. (Spec. 5.) The vendor computer (110) allows the customer computer (120) to download the collected execution data (152) via an execution data collection mechanism (150) located on the customer computer (120). Further, an execution data transmission mechanism (170) located on the customer computer (120), when enabled, transmits at least a portion of the downloaded execution data to the user of another computer via a network. Additionally, the customer computer (120) includes an execution data access mechanism (160) for allowing the customer to access the downloaded execution data (152) on the customer computer only if the execution data transmission mechanism (170) is enabled to allow the vendor to access the downloaded execution data on the customer computer. (Spec. 6.)

Independent claim 1 is illustrative of the invention, and it reads as follows:

1. A computer system comprising:

at least one processor;

a memory coupled to the at least one processor;

an execution data collection mechanism residing in the memory and executed by the at least one processor, the execution data collection mechanism collecting execution data for the computer system;

an execution data transmission mechanism residing in the memory and executed by the at least one processor, the execution data transmission mechanism, when enabled, transmitting at least a portion of the execution data to another computer system coupled to the computer system via a network; and

an execution data access mechanism residing in the memory and executed by the at least one processor, the execution data access mechanism allowing access to the execution data by a user of the computer system only if the execution data transmission mechanism is enabled.

The Examiner relies upon the following prior art in rejecting the claims on appeal:

Mikami	US 5,704,031	Dec. 30, 1997
Farhat	US 6,510,463 B1	Jan. 21, 2003

The Examiner rejects the claims on appeal as follows:

Claims 1 through 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Mikami and Day.

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Mikami

1. Mikami discloses a method and system for allowing clients to perform self-diagnosis and self-repair in a client server network. As depicted in Figure 1, Mikami discloses a management unit (3) that collects contents of an error information file (13) in a server unit (1). Further, the management unit (3) uploads updated software and firmware into the server as backup data to update the client. (Col. 2, ll. 11-37; col. 6, ll. 11-47.)

Day

2. Day discloses a method and system for providing context-sensitive help for users of thin clients that have been redirected from a plurality of partner sites to a back-end server. (Abstract.)

3. As shown in Figure 2, businesses (201, 205) executing thin client programs (HTML/XML) (204, 208) on their computing devices (203, 207) access a business operation center (220) via a data network (210) to perform various transactions such as payroll, human resource management. (Para. [0045].)

4. Day discloses a relational database (228) for storing user data including a hierarchically established set of access privileges thereby preventing an unauthorized user (202) from accessing data under the domain of another user (206). Each user (202, 206) is granted access to a set of privileges permitting them to accede to a certain level of access to the data. (Para. [0047].)

5. Day discloses that the user (202) of a company (201) may have access privileges to data of another company (205), if the data set that has been enabled. (*Id.*)

6. Day discloses that the business operation center (BOC) (220) places a cookie (211, 212) on the user computers (203, 207) such that the user (202, 206) experiences a customized set of applications when it is redirected to the back-end of the BOC from a particular site. (Para. [0048], [0055].)

PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of

underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”). *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41(2007)). “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *KSR*, 127 S. Ct. at 1742.

Discussing the obviousness of claimed combinations of elements of prior art, *KSR* explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraidia [v. AG Pro, Inc.]*, 425 U.S. 273 (1976)] and *Anderson's-Black Rock[, Inc. v. Pavement Salvage Co.]*, 396 U.S. 57 (1969)] are illustrative—a court must ask whether the improvement is more

than the predictable use of prior art elements according to their established functions.

KSR, 127 S. Ct. at 1740. Where the claimed subject matter cannot be fairly characterized as involving the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness can be based on a showing that there was “an apparent reason to combine the known elements in the fashion claimed.” *KSR*, 127 S. Ct. at 1740-41. Such a showing requires “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, 127 S. Ct. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 987(Fed. Cir. 2006)).

The reasoning given as support for the conclusion of obviousness can be based on interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace, and the background knowledge possessed by a person having ordinary skill in the art. *KSR*, 127 S. Ct. at 1740-41. *See also Dystar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2007).

We note our reviewing court has recently reaffirmed that:

[A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the ‘improvement’ is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal—and even common-sensical—we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan

possesses knowledge and skills rendering him capable of combining the prior art references.

Leapfrog, 485 F.3d at 1162 (holding it “obvious to combine the Bevan device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost”).

Also, a reference may suggest a solution to a problem it was not designed to solve and thus does not discuss. *KSR*, 127 S. Ct. at 1742 (“Common sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle. . . . A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

The prior art relied on to prove obviousness must be analogous art. As explained in *Kahn*,

the “analogous-art” test . . . has long been part of the primary Graham analysis articulated by the Supreme Court. *See Dann* [v. *Johnston*,] 425 U.S. [219,] 227-29 (1976), *Graham*, 383 U.S. at 35. The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Oetiker*, at 1447. References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* (“[I]t is necessary to consider ‘the reality of the circumstances,’—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the

inventor.” (quoting *In re Wood*, 599 F.2d 1032 (C.C.P.A. 1979))).

Kahn, 441 F.3d at 986-87. *See also In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (“[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.”).

In view of KSR’s holding that “*any* need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed,” KSR 127 S. Ct. at 1742 (emphasis added), it is clear that the second part of the analogous-art test as stated in *Clay, supra*, must be expanded to require a determination of whether the reference, even though it may be in a different field from that of the inventor’s endeavor, is one which, because of the matter with which it deals, logically would have commended itself to an artisan’s (not necessarily the inventor’s) attention in considering *any* need or problem known in the field of endeavor. Furthermore, although under KSR it is not always necessary to identify a known need or problem as a motivation for modifying or combining the prior art, it is nevertheless always necessary that the prior art relied on to prove obviousness be analogous. *See KSR*, 127 S. Ct. at 1739. (“The Court [in *United States v. Adams*, 383 U.S. 39, 40 (1966)] recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another *known in the field*, the combination must do more than yield a predictable result.”) (emphasis added). *See also Sakraida*, 425 U.S. at 280 (“Our independent examination of that evidence

persuades us of its sufficiency to support the District Court's finding 'as a fact that each and all of the component parts of this patent . . . were old and well-known throughout the dairy industry long prior to the date of the filing of the application for the Gribble patent.'").

§ 103 ANALYSIS

Independent claims 1, 6, 11 through 14, 18, and 24 require in relevant part allowing a user of a computer system to access execution data on the computer system only if an execution data transmission mechanism on the computer system is enabled to transmit at least a portion of the data to another computer system. (Claims Appendix.) Similarly, independent claim 15 requires a business method for enabling a customer to access an execution data on the customer computer system if the customer accepts an offer to access execution data gathered by the customer computer system in exchange for the customer's sharing of the execution data. (*Id.*) With respect to independent claim 1, Appellants argue that neither Mikami nor Day teaches the cited limitation. Further, Appellants argue that there is insufficient rationale for combining the applied references. Therefore, Appellants submit that the combination of Mikami and Day does not render claims 1 through 29 unpatentable. (App. Br. 7-15.)

In response, the Examiner submits that Day teaches the cited limitation as an access mechanism that allows or rejects transitions between computers. The Examiner therefore concludes that the combination of Mikami and Day renders the claims unpatentable. (Ans. 7.)

The issue before us is therefore whether the combination Mikami and Day renders claims 1 through 29 unpatenable under 35 USC § 103 (a)? Particularly, does the proffered combination teach a mechanism that allows a computer user to access execution data on the user's own computer only upon enabling the computer to transmit the execution data to another computer? We answer this question in the negative.

As set forth in the Findings of Fact section above, Mikami discloses a mechanism for allowing a management unit computer to collect error data pertaining to a server on a network, as well as a mechanism for uploading software and firmware data to update computers on the network. (FF 1.) Further, Day discloses a mechanism wherein a user computer can access its own data locally or in a remote database. (FF 4.) Day further discloses that the computer user can access data of another user's computer in the remote database if it has been enabled for direct access. (FF 5.) We find that one of ordinary skill in the art would have readily recognized that the Mikami-Day combination, at best, teaches a system for allowing a computer user to collect data, to transmit the data, to access the data locally or remotely, and to allow another computer user to access the data by enabling a data transmission mechanism. However, the ordinarily skilled artisan would have also recognized that the cited combination does not lend itself to the computer user being able to access previously gathered data on his or her own computer only if the computer allows another computer to access the collected data. In other words, the proffered combination teaches that the computer user can access previously collected data on its machine *unconditionally*. It is therefore silent on the computer user accessing

previously collected data on his/her own computer only if another computer user is allowed to access the collected data on the machine (i.e. transmission mechanism enabled).

It follows that Appellants have shown that the Examiner erred in concluding that the combination of Mikami and Day renders independent claims 1, 6, 11, through 15, 18, and 24 unpatentable. It follows for these same reasons that Appellants have shown that the Examiner erred in concluding that the cited combination renders dependent claims 2 through 5, 7 through 10, 16, 17, 19 through 23, and 25 through 29 unpatentable.

SUMMARY

Appellants have shown that the Examiner failed to establish that claims 1 through 29 are unpatentable under 35 U.S.C. § 103(a) over the combination of Mikami and Day.

DECISION

We reverse the Examiner's decision rejecting claims 1 through 29.

REVERSED

Appeal 2007-2583
Application 09/892,435

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